



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,514	08/24/2001	Jonathan L. Sessler	045404.0003	3535

20790 7590 04/06/2005

AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.  
300 WEST 6TH STREET  
SUITE 2100  
AUSTIN, TX 78701

EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
----------	--------------

1626

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/939,514

Applicant(s)

SESSLER ET AL.

Examiner

Rebecca L. Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 31-51 is/are pending in the application.
- 4a) Of the above claim(s) 5-8, 31-48, 50 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-11 and 49 is/are rejected.
- 7) ☒ Claim(s) 3 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-11 and 31-51 are currently pending in the instant application. Claims 5-8, 31-48, 50 and 51 are withdrawn from consideration as being for non-elected subject matter. Claims 1-4, 9-11 and 49 are rejected. Claims 3 and 49 are objected.

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-4, 9-11 and 49 in the reply filed on 13 December 2004 is acknowledged. The traversal is on the ground(s) that, as stated in the response filed 13 August 2004, the restriction requirement should be withdrawn on the grounds that its imposition is unduly prejudicial to the applicant and that no restriction requirement has been imposed on the initially filed claims and that the imposition of an eight-way restriction in the application at this late date in the prosecution imposes an undue burden on the applicants. Secondly, applicant argues that the restriction is not proper since the invention of Group I can be incorporated into the polymer matrix invention, the membrane product invention or the liposome invention and that the groups VI and VII are methods of manufacture and methods of use for the compounds of structure I. This is not found persuasive because when two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action can require the applicant in the reply to that action to elect an invention to which the claims will be restricted, and such a requirement can be made at any time before the final action, 37 CFR 1.142. In the restriction requirement dated 2/11/04, the examiner withdrew the finality of the office action dated 3/7/2003 and reopened prosecution, therefore, the restriction requirement is proper since it is made before the

final action in this application. Furthermore, the restriction requirement is proper as inventions I-V are independent and distinct products which differ materially in structure and composition, for example, the values for n and R vary in the independent products of I and V, inventions I and V are compounds wherein invention II is a polymer matrix, invention III is a membrane and invention IV is a liposome. Also, while inventions VI and VII are methods for preparing the compounds of structure I and methods of use of the structure I, the method of manufacturing can also be used for preparing the structure VI and the method of using the structure I can be practiced with another materially different product such as aluminum hydroxide or calcium carbonate cocktails.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the parent application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 2, 4, 9-11 and 49 of this application. Applicants instant claims 2,4, 9-11 and 49 which specifically state the value of even numbered R substituents are fluorine and specific n values, or claim specific fluorinated species of the calix[n]pyrrole macrocycle lack written description in the earlier filed US application 09/838998 filed 4/20/2001 which only provides support for a broad genus of calix[n]pyrrole macrocycles wherein R can be halide and n is 4-8. Claims which change the scope relative to the originally filed claims in the parent application may lack written description in the earlier filed US application, see In re Ruschig, 371 F.2d 990, 154 USPQ 118 (CCPA 1967) which supports that the original disclosure of a large genus did

not support a later filed claim to a previously unnamed single species. Furthermore, Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 1326, 56 USPQ2d 1481, 1486 (Fed. Cir.2000) notes that with respect to In re Ruschig, that "Ruschig makes clear that one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say "here is my invention". In order to satisfy the written description requirement, the blaze marks directing the skilled artisan to that tree must be in the originally filed disclosure." Therefore, the claimed invention of claims 2,4, 9-11 and 49 is not for an invention which is also disclosed in the prior application. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

### ***Response to Amendment***

The Sessler declaration under 37 CFR 1.132 filed 31 July 2003 is insufficient to overcome the following 35 USC 102(a) rejections of claims 4, 9 and 49 based upon Sessler et al. or Anzenbacher et al. because: the declaration raises an issue of inventorship with the phrase "and/or" in paragraph 4 of the declaration. Applicant argued in the response filed 1/8/2004 that paragraph 4 of the declaration merely states that the subject matter of each of the claims was invented by one or more of the named inventors either individually or jointly and that such a statement is entirely proper since

an individual is properly and correctly named an inventor if he contributed either jointly or individually to merely one of the claims of the joint application. While the examiner agrees with applicant that an individual is properly and correctly named an inventor if he contributed either jointly or individually to merely one of the claims of the joint application, the examiner does not agree that the statement in paragraph 4 is stating that each of the named inventors contributed either jointly or individually to merely one of the claims of the joint application. Applicants' statement:

"The subject matter of each of claims 1-11 and 31-51 was invented by me, Pavel Anzenbacher Jr., Manuel Marquez, and/or James A. Shriver."

includes instances wherein not all four of the applicants named as inventors of the application contributed to at least one of the claims either jointly or individually. The phrase "and/or" allows the sentence to be read, for example, the following ways:

Jonathan Sessler, Pavel Anzenbacher Jr., and Manuel Marquez invented the subject matter of each of claims 1-11 and 31-51;

Jonathan Sessler, Pavel Anzenbacher Jr., Manuel Marquez and James A. Shriver invented the subject matter of each of claims 1-11 and 31-51; or

Only James A. Shriver invented the subject matter claims 1-11 and 31-51.

Therefore, the issues of inventorship is raised. If only Jonathan Sessler, Pavel Anzenbacher Jr., and Manuel Marquez invented the claimed subject matter or only James A. Shriver invented the claimed subject matter, then the named inventors of the application did not invent the subject matter sought to be patented. Furthermore, If only

Jonathan Sessler, Pavel Anzenbacher Jr., and Manuel Marquez invented the claimed subject matter or only James A. Shriver invented the claimed subject matter then the inventorship of the application still differs from the references cited in the below 35 USC 102(a) rejections even though applicant has stated that Andrew C. Try, Kidekazu Miyaji, Karolina Jursikova, and Vincent M. Lynch did not conceive or otherwise invent the subject matter of the pending claims because the references can still be considered by another when paragraph 4 is read as only Jonathan Sessler, Pavel Anzenbacher Jr., and Manuel Marquez invented the claimed subject matter or only James A. Shriver invented the claimed subject matter. In order to overcome the 35 USC 102(a) rejections below and the 35 USC 102(f) rejection below a new declaration could be submitted clearly stating what subject matter of each of the claims was invented by each of the four named inventors of the application.

### ***Claim Objections***

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 3 states that at least two R substituents are coupled to form a bridged structure wherein the two R substituents are selected from the group consisting of an odd numbered R and a pyrrole R. This fails to further limit the parent claim since the parent claim does not allow for the pyrrole R groups to couple with the odd numbered R groups because the pyrrole R groups are fluoro, chloro, bromo or selected from ii) which is hydrogen, alkyl,

aminalkyl, alkylsulfone, carboxy alkyl, carboxyamidealkyl, phosphor alkyl, alkyl sulfoxide, alkyl sulfone, alkyl sulfide, haloalkyl, aryl, N-oxide, dialkylamino, carbamate, or arylsulfonyl, none of which allow the pyrrole R groups to couple with the odd numbered R groups. Therefore, claim 3 is failing to further limit the subject matter of claim 1.

Claim 49 is objected to because of the following informalities: Claim 49 does not have a period at the end of the sentence. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 1 and 4 state “ a compound comprising”. The term “comprising” which is considered open language renders the claims indefinite since it is unclear what else is included in the compound, i.e. what other atoms, substituents or other substances is applicant considering as part of the claimed compound invention. This application can be overcome by amending claims 1 and 4 to read “ A B-substituted cal[n]pyrrole macrocycle compound having the structure I.”

Claim 49 is rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, compound 48 in claim 49 has the variable R,

however this variable is undefined in the claim which renders the claim indefinite since it is unclear what compounds are being claimed. Claims must, under modern claim practice, stand alone to define an invention, *Ex parte Fressola*, 27 USPQ 2d 1608 (1993).

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 2, 4, 9, 11 and 49 are rejected under 35 U.S.C. 102(a) as being anticipated by Sessler et al. (C100 on IDS) which discloses the compounds B-decafluoro-meso-octamethylcalix[5]pyrrole (compound 4 page 12061), B-hexadecafluoro-meso-octamethylcalix[8]pyrrol(compound 6 page 12061), and octafluorocalix[4]pyrrole (compound 2 page 12061).

Claims 2, 4 and 49 are rejected under 35 USC 102(a) as being anticipated by Anzenbacher et al. which discloses the compound octafluorocalix[4]pyrrole (compound 2, page 10269).

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-4, 9-11 and 49 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Specifically, the named inventors of the application are: Jonathan Sessler, Pavel Anzenbacher Jr., Manuel Marquez and James A. Shriver. However, the declaration filed 31 July 2003 states that:

"The subject matter of each of claims 1-11 and 31-51 was invented by me, Pavel Anzenbacher Jr., Manuel Marquez, and/or James A. Shriver."

The phrase "and/or" allows the sentence to be read, for example, the following ways:

Jonathan Sessler, Pavel Anzenbacher Jr., and Manuel Marquez invented the subject matter of each of claims 1-11 and 31-51;

Jonathan Sessler, Pavel Anzenbacher Jr., Manuel Marquez and James A. Shriver invented the subject matter of each of claims 1-11 and 31-51; or

Only James A. Shriver invented the subject matter claims 1-11 and 31-51.

Therefore, it appears that the inventive entity named in the application may be incorrect since an inventor must contribute to the conception of the invention and the Sessler declaration casts doubt on this. This rejection can be overcome by submitting a new declaration under 37 CFR 1.132 which states what subject matter of each of the claims was invented by each of the four named inventors of the application.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rebecca Anderson  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600  
4/1/05

KAMALA A. SAEED, PH.D.  
PRIMARY EXAMINER

for

Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

*Kamal Saeed*